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10/008,227	11/07/2001	Satoshi Tsujimura	NAK1-BQ38	6960

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EXAMINER

JONES III, CLYDE H

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,227	Applicant(s) TSUJIMURA ET AL.	
	Examiner Clyde H. Jones III	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12 April 2002</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmund et al. (US 6,698,020 B1).

Regarding claims 1, 15, and 16, Zigmund anticipates the apparatus (ad insertion device 80 – fig. 5) (and corresponding method and computer program) for receiving and reproducing programs (col. 6, lines 3-12) comprising:

first receiving means (video switch 90) for receiving programs which are sent via a first transmission path (programming delivery/video programming feed; col. 10, lines 64-67 & col. 15, lines 45-50; 66-fig. 4; col. 8, lines 1-3) to a receiver group (broadcast/cable receivers/subscriber devices serviced by a program provider) made up of a plurality of program reception apparatuses (col. 8, lines 30-33; col. 7, lines 5-25);

second receiving means (AD filter 90 – fig. 5) for receiving programs which are sent via a second transmission path (AD delivery/advertisement stream) different with the first transmission path (col. 11, lines 62-65; col. 14, lines 25-53; col. 15, lines 5-8;

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col. 9, lines 1-4) to a part (at least one receiver/subscriber device) of the receiver group, wherein a program (video programming sent on the video programming feed) received by the first receiving means (video switch 90) is accompanied, at a predetermined timing, with switch information (a trigger event; col. 15, lines 35-61) for specifying a program (advertisement) to be received by a different one of the first and second receiving means (trigger information indicates an advertisement is to be received by a different receiver –AD filter 84-- than the one the video programming is received –video switch 90--) (col. 15, lines 52-57 & 61-65; in which the triggering specifies when to switch from the video programming feed to a selected advertisement from the advertisement feed; col. 17, lines 25-32; 112, 114, 116 – fig. 6);

controlling means (switching decision unit 88) for controlling reception so that one of the first and second receiving means receives a program at one time, the program (video programming/feed) hereafter referred to as a first program (col. 15, lines 57-65); and

extracting means (switch decision unit 88 – fig. 5) for extracting, when the first program is accompanied with the switch information, the switch information (col. 11, lines 8-13; and col. 15, lines 38-58),

wherein the controlling means (switch decision unit 88) includes:

switching means (video switch 90) for switching, when the switch information is extracted by the extracting means, the reception from the first program (video programming feed) to a second program (advertisement; col. 6, lines 13-29) specified

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by the extracted switch information (trigger event) (col. 15, lines 57-65 & 35-37; col. 17, lines 25-37).

Regarding claim 2, Zigmund anticipates the controlling means (switch decision unit 88) further includes:

acquiring means for acquiring return information for specifying the first program (video programming feed), before the reception is switched from the first program to the second program (advertisement) (col. 4, lines 36-51; col. 15, lines 35-37 and lines 40-43 and lines 55-57; in which Zigmund anticipates a triggering event, implied by the video programming feed or based on data from the EPG data, including information/instructions indicating the precise time to switch back/return to the programming feed); and

returning means (switch 90) for switching, when the received second program (advertisement) is accompanied with a return (advertisement completion) signal, the reception from the second program back to the first program specified by the return information (col. 17, lines 35-42; in which the video switch returns transmission to the video programming feed upon determining there is no more available adds, i.e., it detects an ad completion signal accompanying the ads).

Regarding claim 3, Zigmund anticipates the controlling means (the switch decision unit 88) further includes:

acquiring means for acquiring return information for specifying the first program (video programming feed), before the reception is switched from the first program to the second program (advertisement) (col. 4, lines 36-51; col. 15, lines 35-37 and lines 40-43 and lines 55-57; in which Zigmund anticipates the triggering event, implied by the video programming feed or based on data from the EPG data, including information/instructions indicating the precise time to switch back/return to the programming feed);

counting means for counting a predetermined time (length of an advertisement slot) which elapses since the reception is switched from the first program (video programming feed) to the second program (advertisement) (col. 16, lines 30-43); and

returning means (switch 90) for switching, when the predetermined time has elapsed, the reception from the second program (advertisement) back to the first program (video program feed) specified by the return information (col. 4, lines 51-52; col. 17, lines 35-37; col. 15, lines 55-57).

Regarding claim 4, Zigmund anticipates, the switch (trigger event) information includes a return time which is a time period from when the reception is switched from the first program to the second program to when the reception is switched from the second program back to the first program (appropriate time to insert, i.e., interrupt and return, the ad feed into the programming feed), and

the controlling means further includes:

acquiring means for acquiring return information for specifying the first program (video programming feed), before the reception is switched from the first program to the second program (advertisement) (col. 4, lines 36-51; col. 15, lines 35-37 and lines 40-43 and lines 55-57; in which Zigmund anticipates the triggering event, implied by the video programming feed or based on data from the EPG data, including information/instructions indicating the precise time to switch back/return to the programming feed);

counting means for counting the return time which elapses since the reception is switched from the first program to the second program (col. 16, lines 30-43; which inherently discloses a buffer time count in order to use the delay code embedded in the video programming, e.g., a nationally broadcasted program feed is paused/buffered for 30 seconds according to the delay code while an ad is inserted and upon return to the video programming feed the buffer will playback the content it stored 30 seconds ago); and

returning means (switch 90) for switching, when the return time has elapsed, the reception from the second program back to the first program specified by the return information (col. 4, lines 51-52; col. 17, lines 35-37; col. 15, lines 55-57).

Regarding claim 5, Zigmund anticipates the first receiving means (video switch 90) receives a program which is broadcast to the plurality of program reception apparatuses located in a predetermined geographical area (col. 15, lines 45-47; col. 8, lines 29-32; col. 7, lines 2-12 & 17-24; col. 6, lines 30-32), and

the second receiving means (ad filter 84) receives a program (advertisement) which is broadcast to at least one of the plurality of program reception apparatuses located in a part of the predetermined geographical area (col. 8, lines 7-9; col. 12, lines 1-5; and col. 9, lines 15-20).

Regarding claim 6, Zigmund anticipates the first receiving means (video switch 90) receives a satellite broadcast program, and

The second receiving means (ad filter 84) receives a non-satellite broadcast program (col. 12, lines 1-5; col. 9, lines 1-4; and col. 18, lines 22-28; which is encompassed in the embodiment of fig. 5).

Regarding claim 7, Zigmund anticipates the switching means (video switch 90) switches the reception from the satellite broadcast program to the non-satellite broadcast program (col. 15, lines 57-61; col. 17, lines 28-31).

Regarding claim 8, Zigmund anticipates the first receiving means receives a main program (video programming) which is broadcast across the predetermined geographical area (col. 15, lines 45-47; col. 8, lines 29-32; col. 7, lines 2-12 & 17-24; col. 6, lines 30-32), and

the second receiving means receives a commercial (advertisement) or news (informational programming) which is broadcast to only the part of the predetermined

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geographical area (col. 14, lines 25-35 & lines 49-65; col. 9, lines 15-20; col. 6, lines 15-29).

Regarding claim 9, Zigmund anticipates the switching means switches the reception from the main program to the commercial or news (col. 15, lines 57-61; col. 17, lines 28-31).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmund et al. (US 6,698,020 B1).

Regarding claim 10 Zigmund anticipates the controlling means (switching decision unit 88) controls the first receiving means (video switch 90) to receive the first program (video programming) which is accompanied with the switch (trigger event) information, the switch information including transmitter information (explicit/actual

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triggering events; col. 8, lines 55-60; col. 9, lines 5-8; in which Zigmund anticipates triggering events indicating Ad sources/transmitters),

the transmitter information showing a transmitter (ad source) of a program (advertisement) (col. 9, lines 5-8; in which Zigmund anticipates triggering events indicating Ad sources/transmitters),

the extracting means extracts the switch information accompanying the first program (col. 15, lines 49-58; col. 11, lines 8-13), and

the switching means includes: characteristics information storing means (Viewer and system information storage 82- fig. 5) for storing characteristics information showing characteristics of the program reception apparatus (system information) or a user of the program reception apparatus (viewer information);

transmitter specifying means for specifying a transmitter, based on transmitter information that matches the characteristics information stored in the characteristics information storing means (col. 14, lines 25-65; col. 13, lines 7-12; col. 11, lines 24-55); and

switch executing means (video switch 90) for instructing the first receiving means to stop receiving the first program, and instructing the second receiving means to receive a program from the specified transmitter as the second program (col. 15, lines 57-65; col. 15, lines 35-37; col. 17, lines 25-37; col. 9, lines 5-8).

In this embodiment (figure 5), Zigmund fails to disclose characteristics information which are in a one-to-one correspondence with the programs that can be received by the second receiving means, and the characteristics information showing

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characteristics of users or program reception apparatuses that should receive the program.

However in another embodiment (figure 8), Zigmund discloses inserting a crossover link in the programming feed which indicates Internet capable (characteristic) reception apparatuses, e.g., WebTV devices, can receive a one-to-one corresponding (internet site/web page related to the address) advertisement (col. 18, lines 38-43 and lines 56-66; col. 19, lines 12-21 and lines 34-37). Zigmund does this for offering a wide variety of subjects or topics fitting user criteria (preferences) while simultaneously displaying the video programming (col. 5, lines 5-8; col. 18, lines 44-56);

It would be obvious to one of ordinary skill in the art to modify the system of Zigmund (figure 5) to include characteristics information which are in a one-to-one correspondence with the programs that can be received by the second receiving means, and the characteristics information showing characteristics of program reception apparatuses that should receive the program, as taught by Zigmund (related to figure 8), for the advantage of selecting advertisements using the web browsing capability of a WebTV box (col. 10, lines 23-25; col. 11, lines 18-21).

Regarding claim 11, Zigmund teaches the first receiving means (video switch 90) receives a television program which is broadcast one-sidedly (nationally broadcast over-the-air) to unspecified program reception apparatuses (col. 7, lines 2-7 and 17-19), and

the second receiving means receives an internet program which is transmitted to only program reception apparatuses which have requested the internet program (col. 19, lines 12-19; col. 15, lines 5-17).

Regarding claim 12 Zigmund teaches the switching means (switch 90) switches the reception from the television program to the internet program (col. 19, lines 19-21; col. 17, lines 30-32; col. 15, lines 59-65).

Regarding claim 13, Zigmund teaches the first receiving means (video switch 90) receives a main program which is broadcast across a predetermined geographical area (col. 15, lines 45-47; col. 8, lines 29-32; col. 7, lines 2-12 & 17-24; col. 6, lines 30-32), and the second receiving means receives a commercial or news (informational programming) which is broadcast to only a part of the predetermined geographical area (col. 19, lines 19-21; col. 17, lines 30-32; col. 15, lines 59-65; col. 14, lines 25-35 & 49-65; col. 9, lines 15-20; col. 6, lines 15-29).

Regarding claim 14, Zigmund teaches the switching means switches the reception from the main program to the commercial or news (col. 15, lines 57-61; col. 17, lines 28-31).


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clyde H. Jones III whose telephone number is 571-272-5946. The examiner can normally be reached on 9-5:30 p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CJ


CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
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